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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,281	09/18/2003	Guy Joseph Clamen	A01432	5617

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EXAMINER

WOOD, ELIZABETH D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,281

Applicant(s)

CLAMEN ET AL

Examiner

Elizabeth D. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/23/03, 4/14/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Specification

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

Note, for example, page one of the specification, last sentence, is not a complete sentence.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition containing an alkaline agent selected from an amine or an alkaline earth base as set forth on page 4 of the specification, does not reasonably provide enablement for the recitation of an

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"alkaline agent" generically which includes substances neither contemplated nor disclosed by applicants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition containing an hydration inhibitor selected from a polymer or copolymer of polycarboxylic acid as set forth on page 4 of the specification, does not reasonably provide enablement for the recitation of an "hydration inhibitor" generically which includes substances neither contemplated nor disclosed by applicants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a composition containing an activator selected from metal salt which can provide acidic cations as set forth on page 6 of the specification, does not reasonably provide enablement for the recitation of an "activator" generically which includes substances neither contemplated nor disclosed by applicants. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

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These claims are considerable broader than the enabling disclosure.

Note in the rejection below that the examiner has not limited the examination of these components to those disclosed, but has made a rejection based upon what would be embraced by applicants' generic terminology.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

It is unclear how the composition could have 99 wt% alkaline first polymer if there must be at least 50 wt% gypsum in the composition. It is further unclear how it the composition could have 99 wt% second polymer if there must be at least 30 wt% filler.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,779,786 to Patel.

The instant invention involves a gypsum composition designated as containing "Component A" and "Component B". Component a contains gypsum, a polymer an alkaline agent and a hydration inhibitor and component B comprises an additional polymer, a filler and an activator. Method of making the

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composition by mixing component a and Component B is also claimed. It should be noted that for the purposes of claim construction and the following rejection, the examiner does not consider the designations "A" and "B" to carry any patentable weight or significance. Once the substances are mixed, there is no difference in the actual formed composition and a reference containing all of the components would be considered to anticipate the instantly claimed composition.

Patel discloses a composition that can contain a mixture of copolymers (reads on applicants' first and second polymers", metallic salt (reads on applicants' "activator"), limestone (reads on applicants' "alkaline agent" and/or filler), water (reads on applicants' "hydration inhibitor").

Patel differs from the instantly claimed composition and method primarily in that the components are not designated into "Component A" and "Component B" categories by the reference and the order of mixing differs.

It is considered that this is clearly a classic matter of design choice. Those skilled in the cement art are aware that the order of addition of substances must be modified depending on when and where the composition is to be employed, i.e. pre-mix storage stable or immediate on-site preparation is determined beforehand and the compositions are prepared accordingly.

See particularly the abstract, the claims, column 5, line 42 – column 6, column 7, lines 10-67.

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Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,432,157.

GB 1,432,157 discloses a composition that can contain a mixture of copolymers (reads on applicants' first and second polymers", metallic salt (reads on applicants' "activator"), amine (reads on applicants' "alkaline agent"), filler and water (reads on applicants' "hydration inhibitor").

Patel differs from the instantly claimed composition and method primarily in that the components are not designated into "Component A" and "Component B" categories by the reference and the order of mixing differs.

It is considered that this is clearly a classic matter of design choice. Those skilled in the cement art are aware that the order of addition of substances must be modified depending on when and where the composition is to be employed, i.e. pre-mix storage stable or immediate on-site preparation is determined beforehand and the compositions are prepared accordingly.

See particularly page 1, line 49-page 3, line 70.

Any minor differences in the limitations of the dependent claims have been considered. This statement is meant to include limitations such as the effective amount of components or the place of application of the composition. These limitations would have been obvious to the skilled artisan because the references are also concerned with making gypsum compositions and would therefore have found proportions easily arrived at since cementing compositions have predictable properties and various components are added in effective amounts for known reasons.

Furthermore, any such differences are deemed to be result-effective variables that one of ordinary skill in the art would be expected to manipulate to advantage. Additionally, such limitations can be considered to have been simply known as conventional to the artisan practicing in the art at the time the invention was made and/or were common practices which were so well known in the art that they would have been taken for granted. MPEP 706.02(a).

If applicants believe that one or more limitations are critical to the invention, then applicant should amend the claims to reflect such critical limitations as well as indicate where in the specification such critical limitations were discussed and demonstrated.

The limitations of all claims have been considered and are deemed to be within the purview of the prior art.

Conclusion

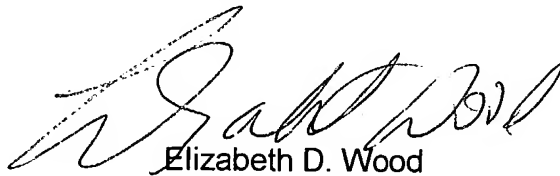
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Applicants are advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 571-272-1377. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1364. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth D. Wood
Primary Examiner
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